PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number: 07844-610001/P563

	Application Number 10/665,156	Filed September 18, 2003
CERTIFICATE OF MAILING BY EFS-WEB FILING I hereby certify that this paper was filed with the United States Patent and Trademark Office using the EFS –WEB system on this date: DECEMBER 18, 2007	First Named Inventor William Lin	
	Art Unit 2176	Examiner Maikhanh Nguyen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
        Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
    See 37 CFR 3.71. Statement under 37 CFR 3.73(b)
    is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record _____51,943_____
                                                    (Reg. No.)

☐ attorney or agent acting under 37 CFR 1.34.
    Registration number if acting under 37 CFR 1.34

_____
                Signature

Arrienne M. Lezak
Typed or printed name

(650) 839-5070
Telephone number

December 18, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below'.

☒ Total of 1 forms are submitted.

50448897.doc

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : William Lin   Art Unit : 2176
Serial No. : 10/665,156   Examiner : Maikhanh Nguyen
Filed : September 18, 2003   Conf. No. : 6282
Title : CORRECTING VALIDATION ERRORS IN STRUCTURED DOCUMENTS

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

<u>PRE-APPEAL BRIEF REQUEST FOR REVIEW</u>

This request is filed specifically in response to legal and factual deficiencies in the final Office Action mailed September 18, 2007, and the Advisory Action mailed December 12, 2007. The applicant respectfully submits that the examiner has not shown a *prima facie* case of obviousness.

Claims 1-4, 6-8, 10-19, 21-23, 25-30, and 33-44 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Pubublication No. 2004/0066744 A1 ("Jones") in view of U.S. Patent No. 7,168,035 B1 ("Bell). Claims 9, 24, 31, and 32 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Jones and Bell in view of U.S. Patent Pub. No. 2004/0268304 A1 ("Kuo").

To establish a *prima facie* case of obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations" [MPEP, §2143]. Even in combination, Jones and Bell fail to disclose all the limitations recited in claim 1.

Specifically, claim1 recites suggesting one or more changes to a user that would correct the identified non-conforming structural aspect. The suggested one or more changes are presented to the user in a predetermined suggestion template corresponding to a specific validation error. The predetermined suggestion template includes logic necessary to implement the one or more changes to the document to correct the identified non-conforming structural aspect.

In rejecting claim 1, the examiner relies upon paragraph #0034 of Jones as teaching "suggesting one or more changes to a user which would correct the identified structural aspect"

CERTIFICATE OF MAILING BY EFS-WEB FILING

I hereby certify that this paper was filed with the United States Patent and Trademark Office using the EFS –WEB system on this date: <u>DECEMBER 18, 2007</u>

(Office Action mailed September 18, 2007, page 3 and the Advisory Action mailed December 12, 2007, page 2). The examiner specifically cites portions of paragraph #0034 in the Advisory Action. Paragraph #0034 of Jones reads as follows:

> Error data 235 includes data returned to the word-processor 120 from XML validation engine 225 when an error has occurred with relation to elements validated by XML validation engine 225. Error data 235 may also include information for displaying a notification of the errors by word-processor 120. In one embodiment, four separate types of errors are reported by word-processor 120 when an error results from validation. The four types of errors include a location error, an invalid contents error, a missing contents error, and an invalid attribute error. Different types of errors may also be used other than the four described. Designating the error as a certain type of error simplifies the analysis that must be performed to rectify the error. Error data 235 may also include further information related to the error, such as suggestions about how to possibly rectify the error which may be displayed to the user. Display and relation of error information is described further with respect to FIG. 8.

Additionally, on page 4 of the Office Action, the examiner indicates that "Jones does not specifically teach the use of the predetermined suggestion template. Bell teaches the use of the predetermined suggestion template" (emphasis added). The cited portion of Bell (col. 5, lines 21-28), reads as follows:

> In block 406 of method 400, an XML data structure is presented on a user interface to a user. The XML data structure is visually presented as a hierarchical arrangement of nodes in a tree structure. Each node can be hierarchically above or below one or more nodes. The XML data structure can be associated with annotations for an XML Schema (or "XSD"). This association is seen in FIGS. 3-4 as XML Data Structure with XSD annotation 302.

The applicant respectfully submits that in the Final Office Action, the examiner failed to reject the applicant's claims in their entirety. Claim 1 recites suggesting one or more changes to a user which would correct the identified non-conforming structural aspect, the suggested one or more changes being presented to the user in a predetermined suggestion template corresponding to a specific validation error, the predetermined suggestion template including logic necessary to implement the one or more changes to the document to correct the identified non-conforming structural aspect.

The applicant respectfully submits that the examiner's identification of a predetermined suggestion template in Bell does not disclose or suggest a predetermined suggestion template corresponding to a specific validation error where the predetermined suggestion template includes logic necessary to implement one or more changes to a document in order to correct an identified non-conforming structural aspect in the document.

More specifically, Bell teaches a means by which "a designer uses a forms designer application to build electronic forms from hierarchical data" (Bell, Abstract). Additionally, Bell teaches the display of hierarchical data, the facilitation of the selection of a portion of the hierarchical data, and the display of one or more transformation-language components associated with the selected portion of hierarchical data. Finally, Bell teaches the generation of an electronic form from the transformation-language components selected by the designer (Bell, Abstract).

The applicant respectfully submits the suggested transformation language components cited by the examiner to teach a predetermined suggestion template are merely suggestions to be used by a designer when generating an electronic form. These suggestions are unrelated to specific validation errors and they do not in any way include the logic necessary to implement one or more changes to a document in order to correct an identified non-conforming structural aspect in the document, as required by claim 1.

Moreover, though Jones teaches "error data [which] may also include further information related to the error, such as suggestions about how to possibly rectify the error which may be displayed to the user" (Jones, paragraph #0034), Jones does not in any way disclose that the suggestions are shown in a predetermined suggestion template and that the suggestions are associated with specific validation errors. Jones merely provides "suggestions about how to possibly rectify the error", which is not a suggestion that includes the logic necessary to implement one or more changes to a document in order to correct an identified non-conforming structural aspect in the document. In other words, suggestions to possibly rectify an error does not disclose or suggest the capacity of the suggestion template to correct that error. For example, the suggestion could be manual operations to be performed by a user in order to correct an error. In contrast, the claimed suggestion template includes the logic necessary to implement a change in a document to correct a specific error (e.g., a non-conforming structural aspect).

The applicant respectfully submits that nowhere in the Office Action mailed September 18, 2007, does the examiner specifically identify art to address the portion of the applicant's claim language requiring that the predetermined suggestion template <u>corresponds to a specific validation error where the predetermined suggestion template includes logic necessary to implement one or more changes to a document in order to correct an identified non-conforming structural aspect in the document.</u>

In the Advisory Action mailed December 12, 2007, the examiner again relies upon Jones and Bell as noted above. Additionally, the examiner cited a new portion of Bell that was not cited in the Final Office Action. The newly cited portion of Bell is relied upon for teaching a "predetermined suggestion template", and reads as follows:

> Just as changes can be made to which component a field is associated with, so also can changes can be made to which node a field is associated with. A change in the node for a field can be implemented as a command on a context menu. When the user selects this command, a list of possible nodes can be presented to the user, and the user may select a new node from the list. A validation routine can be used to validate that the selected node is an appropriate choice for the view component by the following rule: if the component which produced the selected view component would have been suggested for the selected node according to predetermined criteria, the selected node is considered to be a "valid" node for the field. (Bell, Col. 27, line 57 through Col. 28, line 3).

As noted above, Bell teaches a means by which "a designer uses a forms designer application to build electronic forms from hierarchical data" (Bell, Abstract). The applicant submits that if the electronic forms are meant to read upon the applicant's predetermined suggestion template, then the electronic forms themselves would need to correspond to a specific validation error.

The fact that the forms in Bell have an associated validation routine is irrelevant in light of the fact that the validation routine does not disclose or suggest a predetermined suggestion template corresponding to a specific validation error. In fact, Bell does not teach or suggest any type of template associated with the validation routine, let alone the applicant's predetermined suggestion template corresponding to a specific validation error. Additionally, as Bell does not teach or suggest a predetermined suggestion template corresponding to a specific validation error, Bell also does not teach or suggest a predetermined suggestion template including logic

necessary to implement one or more changes to a document in order to correct an identified non-conforming structural aspect in the document, as further required by claim 1.

Thus, the applicant respectfully submits that the cited portions of Jones and Bell relied upon by the examiner do not disclose or suggest a predetermined suggestion template corresponding to a specific validation error where the predetermined suggestion template includes logic necessary to implement one or more changes to a document in order to correct an identified non-conforming structural aspect in the document.

Accordingly, since the references combined do not teach or suggest all limitations of claim 1, a prima facie case of obviousness has not been established.

Claims 10, 13, 16, 25, 28, and 33 contain limitations corresponding to those of claim 1 and were rejected for the same reasons. Therefore, claims 10, 13, 16, 25, 28, and 33 are allowable for the same reasons as set forth above with respect to claim 1.

Additionally, the remaining claims depend from independent claims 1, 10, 13, 16, 25, 28, and 33 and are allowable for at least the reasons that apply to those independent claims.
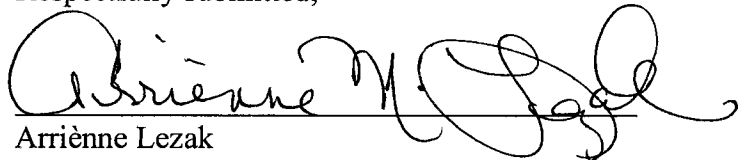
The rejections of record are clearly improper and without basis and should be withdrawn. Moreover, it is respectfully submitted that all of the claims are in condition for allowance, and a notice of allowance is respectfully requested.

Please apply the notice of appeal fee ($500), and any other necessary charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: December 18, 2007

Arriènne Lezak
Reg. No. 51,943

Customer Number: 21876
Fish & Richardson P.C.
Telephone: (650) 839-5070
Facsimile: (650) 839-5071

50454420.doc